

REMARKS

Claims 1 and 14-26 are currently pending in the present application.

Election/Restriction

In the Office Action dated February 8, 2005, the Examiner indicated that because this application is a “continuation” application, which is defined as an application for “the same invention claimed in a prior nonprovisional application,” the election of Species I (Figures 1-4) from the parent application 09/902,636 was being carried over and applied in this continuing application. (Office Action, page 2).

The Applicants respectfully request reconsideration of the carrying over of the election from the parent to this application. MPEP § 819 states as follows:

Where a continued prosecution application (CPA) filed under 37 CFR 1.53(d), is a continuation of its parent application and not a divisional, or where a File Wrapper Continuation (FWC) filed under former 37 CFR 1.62, is a continuation of its parent application and not a divisional or C-I-P, an express election made in the prior (parent) application in reply to a restriction requirement carries over to the CPA or FWC application unless otherwise indicated by applicant. In no other type of continuing application may an election carry over from the prior application.

The current application is not a CPA or FWC application. Instead, it is a continuation application under 37 CFR § 1.53(b). Accordingly, the Applicants respectfully submit that, under MPEP § 819, the election from the parent application should not be carried over to this application.

Moreover, the Applicants respectfully submit that even if this application were a CPA or FWC application, the election from the parent application still should not be carried over because the Applicants, by Preliminary Amendment dated July 15, 2003, added new claims 25 and 26, directed to Species II (Figures 5-6) and Species III (Figure 7), respectively. Thus, by the

addition of these claims, the Applicants indicated that a change in election is desired. MPEP § 819 states:

Where there is no indication in the CPA or FWC application that a change in election is desired, the examiner's first action should include a repetition of the restriction requirement made in the prior application to the extent it is still applicable in the CPA or FWC application and a statement that prosecution is being continued on the invention elected and prosecuted by applicant in the prior application. Examples of what is meant by the phrase "otherwise indicated by applicant" would be where the CPA or FWC is filed as (A) a divisional or (B) a continuation and includes an amendment filed prior to first action in the CPA or FWC adding claims to an invention not previously elected. In each of these examples the examiner should make a new restriction requirement in the first action.

Accordingly, because this application is not a CPA or FWC, and because the Applicants have indicated a desire to elect a different species (at least through the addition of claims 25 and 26 directed to Species II and Species III), the Applicants respectfully request reconsideration of the Examiner's carrying over of the election of Species I from the parent application to this application.

The Applicants also respectfully submit that claim 1 as previously presented was generic in that it covered certain embodiments within each of Species I, II, and III. In the Office Action, the Examiner pointed out that the Examiner previously disagreed that claim 1 was generic and further stated that "applicant appears to agree [that claim 1 is not generic] since in the response mailed on 4/2/03 no remarks were made about the issue."

The Applicants respectfully point out that in the response mailed on 4/2/03, claim 1 was canceled. Therefore, at that time, the issue of whether claim 1 was generic was moot. There was no reason for Applicants to address claim 1 in that response. Thus, the Applicants respectfully

submit that the fact that Applicants made no remarks about claim 1 in the 4/2/03 response should not be construed as agreement that claim 1 is not generic.

The Specification specifically states that the embodiments of Species II and III may be used to deploy a plurality of ligation bands from the distal end of end of the apparatus. (See page 7, line 9, and page 8, line 9). Thus, as previously presented, claim 1 was generic because it embraced certain embodiments within each of Species I, II, and III – e.g., those embodiments in which the devices of Species II and III are used with ligating tips and ligating bands -- although claim 1 did not necessarily embrace all embodiments within those species.

In any event, claim 1 has been amended to recite “a mechanism for moving the string a predetermined first distance to deploy a first of the medical appliances and for moving the string a predetermined second distance to deploy a second of the medical appliances.” As currently amended, claim 1 reads on certain embodiments within Species II and III and not Species I. The Applicants respectfully point out that dependent claims 25 and 26, both of which depend from claim 1, read on Species II and III, respectively.

Priority/Specification

In accordance with the Examiner’s suggestion, the priority data is now recited as presented in the Preliminary Amendment filed on July 15, 2003. In addition, the Applicants wish to thank the Examiner for pointing out that certain specification changes in the Preliminary Amendment filed on August 17, 2004 showed changes from the original Specification instead of from the earlier Preliminary Amendment. In order to avoid confusion of different versions of certain paragraphs, this Amendment deletes certain paragraphs and includes new paragraphs. No new matter has been entered. The Abstract of the Disclosure has also been amended.

Claim Rejections

Claim 1 was rejected under 35 U.S.C. § 102(b) in view of U.S. Patent No. 5,398,844 to Zaslavsky. The Applicants respectfully submit that Zaslavsky does not disclose or suggest “a mechanism for moving [a] string a predetermined first distance to deploy a first of the medical appliances and for moving the string a predetermined second distance to deploy a second of the medical appliances” as is now claimed in claim 1.

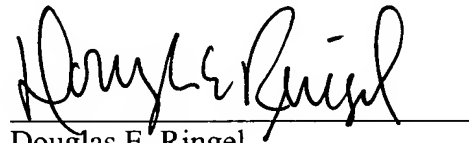
Claim 1 was also rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4, 13, and 15 of U.S. Patent No. 6,632,228, on grounds that claim 1 was the “generic” invention and the patented claims were “species” of the generic invention. The Applicants respectfully submit that the amendment to claim 1 overcomes this rejection, as claims 4, 13, and 15 of U.S. Patent No. 6,632,228 do not include the requirement of “a mechanism for moving [a] string a predetermined first distance to deploy a first of the medical appliances and for moving the string a predetermined second distance to deploy a second of the medical appliances” as is now claimed in application claim 1.

Conclusion

On the basis of the foregoing, the Applicants respectfully request reconsideration of this application and the pending claims. Should any questions arise, the Examiner is invited to contact the undersigned at (202) 220-4225. The Commissioner is hereby authorized to charge any fees and credit any overpayments associated with this filing to Kenyon & Kenyon Deposit Account No. 11-0600.

Respectfully submitted,

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